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12/20/2005

Jan Vink

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12/04/2009

NXP, B.V.

NXP INTELLECTUAL PROPERTY & LICENSING

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EXAMINER

CARDWELL, ERIC

ART UNIT

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/561,461
Filing Date: December 20, 2005
Appellant(s): VINK, JAN

Robert J. Crawford
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 26th, 2009, appealing from the Office action mailed January 26th, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g. patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

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60/471151

Widergren

11-2004

6671701

Chouinard

12-2003

Official Notice

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Widergren [US20040228169] in view of Chouinard [US6671701]. Widergren teaches a system and method of storing digital media in one format that can be converted to another format. Chouinard teaches maintaining real-time synchronization of data in

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different formats. The examiner has reviewed the applicant's admitted prior art and has come to the understanding that the prior implementations of such devices used to supply media in various formats were of two basic designs. Design one is composed of a storage device that contains multiple copies of the same file in various formats (or contains a second format copy of each of a plurality of files) which requires large amounts of storage capacity. Design two is composed of a storage device that contains a single file format and a transcoder that is used to convert the single file into multiple formats (or is used to convert any of a plurality of files stored in a first format to a second format) and when a format is requested the transcoder requires a large amount of processing capacity and power. The examiner believes that the applicant's invention falls in the middle of these two designs and for that reason the examiner believes the applicant's invention to be rendered obvious.

Regarding claims 1 and 6-9, Widergren teaches a storage device [see Widergren's provisional application 60/471,151, page 1, last paragraph, lines 2, "...multimedia stored memory content..."] with an input for receiving a first data [Widergren page 1, last paragraph, line 7, "...hardware devices on which they are attached..."] set having a first format [Widergren page 2, second full paragraph, line 2, "...audio or video content on the same MMC..."]. The device contains various decoders [Widergren page 3, first partial paragraph, lines 5-6, "... decoder program for each operating system..."] that are used to transform the first data into a second data with a different format than the first data [Widergren page 2, first full paragraph, lines 1-13, "...

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compress (encoded) format decode the content..."]. The device contains a storage medium for storing a set of first data pieces [Widergren page 1, last paragraph, line 3, "... storing information of interest ..."].

Widergren does not teach the use of a processor to search for the requested second data sets stored on the storage medium because Widergren does not teach storing the second data sets on the storage medium. Widergren teaches transcoding the data stored in the first format as needed by the user, using whichever conversion program is appropriate.

However, Chouinard does teach a processor [Chouinard figure 2, feature 106] that searches for the requested second data format stored on the storage medium [Chouinard column 3, lines 5-9 and claim 1, feature C].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Widergren's device so that it would store at least some transcoded files because storing transcoded files allows the device to provide these transcoded files immediately to the user, whereas Widergren's device has to transcode them each time they are desired by the user. While it is true that Widergren's device is more secure because it never stores a transcoded file, it would have been obvious to one of ordinary skill in the art at the time the invention was made to give up this security in some environments for the sake of improved speed of access. Storing the transcoded data on the storage device is also made obvious by Widergren's mention of security, as a reason for not storing the data, because that means that past implementations had to have stored the transcoded data on the device for there to be a

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lack of security. The decision of whether to store the transcoded files on Widergren's device is a design choice with the tradeoff being reduced security for the decoded file but enhanced operation speed in providing the file to the user. In consumer devices, speed of access can be critical so it would have been obvious to one of ordinary skill in the art at the time the invention was made to give up the security provided by Widergren to get enhanced speed by storing decoded files. The finite size of Widergren's memory device would lead the skilled artisan to only store some of the files in the decoded format (no room for all of them) so if a user requests one that is not stored, it has to be transcoded.

Given the combination of references, if the search fails because there are no second formats available then the process proceeds as normal and Widergren will transcode the first data set into the second data set and supply it to the reproduction device [Widergren page 10, first paragraph, line 1, "... using a pocket pc, play the video."].

Regarding claim 2, as per the combination in claim 1, Widergren teaches a priority that a data set is never fully decoded into memory, only a subset of the file. The first half is deleted from memory when the second half is being decoded [Widergren page 12, second full paragraph, lines 1-2, "...never decrypted at once..."].

Regarding claim 3, as per the combination in claim 1, Widergren teaches a device that can be used for video or audio [Widergren page 2, second full paragraph,

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line 2, "...audio and video..."]. The device can be loaded with multiple decoders [Widergren page 3, first partial paragraph, lines 5-6, "... decoder program for each operating system..."], these decoders can be used as decompressors, because the first set of data is compressed [Widergren page 2, first full paragraph, line 3, "...compressed..."]. Thus the second set of data will be uncompressed and therefore larger in size than the first set.

Regarding claim 4, as per the combination in claim 1, Widergren teaches coupling the storage device to the reproduction device via a wireless channel [Widergren page 2, first full paragraph, line 8, "...cell phones..."].

Regarding claim 5, as per the combination in claim 1, Widergren teaches that the device can be used in cell phones to contain audio clips [Widergren page 13, first paragraph, last line, "... PDA/Cell phone."]. The Examiner determines these devices to have the ability to pick up audio from a built in microphone that is used to transmit voice over a wireless connection. The examiner takes Official Notice that it would have been obvious at the time of the invention to modify a cell phone to store the transmitted audio for either personal records or entertainment purposes. It is also well known in the art that all cell phones by their inherent function have build in speakers for audio reproduction.

(10) Response to Argument

The appellant argues that the references fail to teach **searching for and supplying stored transcoded data when available and generating transcoded data when a stored version is unavailable.** The examiner has determined that Widergren teaches transcoding one file format into another file format. Widergren generates transcoded data when a stored version is unavailable and delivers the data to a reproduction device [Widergren page 2, first full paragraph, lines 1-13, "... compress (encoded) format decode the content..."]. Widergren does not teach storing the entire transcoded data due to security reasons [Widergren page 5, second paragraph]. The examiner has determined that if Widergren is aware of the concerns for security in having the whole transcoded file stored on the device, because a person could steal the second transcoded data, this would make it obvious to one skilled in the art that it was known at a time previous to store the entire second transcoded document on the device. The examiner has stated in the rejection that Widergren fails to teach searching for stored transcoded data and the examiner has shored up this deficiency with the inclusion of the reference Chouinard. Chouinard teaches transcoding a first file into a second file and storing the second file. Chouinard teaches searching for transcoded files. More specifically Chouinard teaches in claim 1 section C "determining if the source files found by the search has been previously converted into the specified second format". Chouinard then teaches in section D of claim 1 if they haven't been converted to then convert the source files into the second format. If the files have been converted the Chouinard teaches the action of searching those files to make sure they are up to date and that the contents have not changed in sections H and I. For these

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reasons Chouinard teaches searching a location for transcoded data files and therefore the combination of Widergren and Chouinard read on the independent claims as currently presented.

The appellant argues that the Widergren reference **teaches away from storing data in a second format**. The examiner will reiterate the reasons why the Widergren reference renders the actions of storing a second format as obvious. Widergren generates transcoded data when a stored version is unavailable and delivers the data to a reproduction device [Widergren page 2, first full paragraph, lines 1-13, "... compress (encoded) format decode the content..."]. Widergren does not teach storing the entire transcoded data due to security reasons because a person could steal the second transcoded data. Widergren's showing of concern over security means that at some point previous to Widergren's invention, the transcoded data would have been stored on device leading to a security issue. It is Widergren's invention that suggests a method of correcting these previous security issues. Widergren's teachings and concerns over security would make it obvious to one skilled in the art that it was known at a time previous to store the entire second transcoded document on the storage device.

The appellant argues that the rejection relies upon appellant's **disclosure as motivation for storing a subset of second data pieces and an "obvious to try" assertion**. The examiner has used two references, one that stores none of the second

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transcoded file due to security reasons and a second reference that stores the entire second transcoded file. The appellant claims storing a portion of the second transcoded file on the storage device. The examiner has determined that the appellant's invention fits right in between the inventions presented in the references since the appellant's invention does not store all the data but stores at least some of the data. The examiner has determined that since it does fall in the middle of two known inventions that it would have been obvious to one skilled in the art at the time the invention was made to store a subset of the entire piece. This would have been obvious because one skilled in the art would want to find the best balance between storage space and processing time. The easiest variable that the inventor can change is the amount of storage space taken up by the transcoded file. The minimum storage space required was already accomplished by Widergren and the maximum was already accomplished Chouinard so therefore it would have been obvious to store only a subset of the transcoded file.

The appellant argues that the examiner **improperly relies upon official notice**. The examiner took official notice regarding claim 5 which states "wherein the storage device comprises an audio recorder and the reproduction device comprises one or more loudspeakers". The examiner rejected claim 5 with Widergren [page 1, paragraph 1] [page 2, middle paragraph] [page 13, first and second paragraph] that states Widergren's invention is directed towards Multimedia Memory cards and that such cards are used for storage in devices such as cell phones and personal digital assistants (PDAs). The examiner used official notice to state that it would have been obvious at

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the time of the invention for one of ordinary skill in the art to understand that all cell phones, by their very nature, include an audio capture device (microphone) and one or more loudspeakers for sound reproduction. The examiner determined that all three elements of claim 5, those being a storage device, audio recorder, and a loud speaker, are all contained in paragraph 0002 of Widergreen. The examiner simply stated that it would be obvious for one skilled in the art at the time of the invention to understand how to make those components store recorded audio.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Eric S Cardwell/
Examiner, Art Unit 2189

Conferees:

/Kevin L Ellis/
Supervisory Patent Examiner, Art Unit 2117

/Reginald G. Bragdon/
Supervisory Patent Examiner, Art Unit 2189